

Appl. No. : 10/599,135
Filed : December 7, 2006

REMARKS

Claim 14 has been amended to clarify subject matter. Claim 17 has been added. Support can be found in original Claim 14. No new matter has been added. Applicant respectfully requests entry of the amendments and reconsideration of the application in view of the amendments and the following remarks.

Information Disclosure Statement

The Examiner points out: "The prior art references recited in Specification paragraph [0015] are to be listed on form PTO-1449, and copies of the recited prior art references provided for review." *Office Action* p. 2.

In response, Applicants respectfully submit that each Japanese Patent cited in paragraph [0015] but not listed on form PTO-1449 corresponds to a Japanese Patent Laid-open publication as indicated on the front page of the Japanese Patent and as shown below, and each corresponding Japanese Patent Laid-open publication is already listed and recorded on form PTO-1449.

- Japanese Patent No. 2903256: Japanese Patent Laid-open No. 04-185792
- Japanese Patent No. 2591685: Japanese Patent Laid-open No. 03-269199
- Japanese Patent No. 1755152: Japanese Patent Laid-open No. 03-124895
- Japanese Patent No. 3306860: Japanese Patent Laid-open No. 10-226982
- Japanese Patent No. 2889159: Japanese Patent Laid-open No. 09-078491
- Japanese Patent No. 2960002: Japanese Patent Laid-open No. 09-176985

In view of the above, Applicants believe that the Examiner have effectively considered these Japanese Patents.

Rejection of Claims 14-16 Under 35 U.S.C. § 112

Claims 14-16 have been rejected under 35 U.S.C. § 112, second paragraph, with regard to the phrases "if the paper is a printing paper" and "if the paper is a neutral newsprinting paper" in Claim 14.

Claim 14 has been amended to clarify the subject matter by deleting the allegedly indefinite phrases, thereby obviating this rejection.

Rejection of Claims 1-16 Under 35 U.S.C. § 102

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Claims 1-16 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Yoshimura (JP 2004-289221), (English version US 2008/0096008 is used in the Office Action).

Applicants note that JP 2004-289221 (September 30, 2004) is not a publication number, but an application number. The earliest publication date of Yoshimura is April 6, 2006 as explained below.

As indicated on the front page of US 2008/0096008, US 2008/0096008 corresponds to International Application No. PCT/JP05/17966 which claims priority to Japanese Patent Application No. 2004-289221 and No. 2005-227079. Japanese Patent Application No. 2004-289221 and No. 2005-227079 are constructively abandoned and were never published in favor of International Application No. PCT/JP05/17966 under Japanese Patent Law.

The publication date of each case is as follows:

- US 2008/0096008: Publication date: April 24, 2008
- PCT/JP05/17966: Publication date: April 6, 2006 as WO 2006/035878 A1;
May 15, 2008 as JP 2006/035878 A1 (JP national phase application)

As shown above, the earliest publication date of Yoshimura is April 6, 2006.

The instant application is the U.S. National Phase under 35 U.S.C. §371 of International Application PCT/JP2005/004574, filed March 15, 2005 (which claims priority to Japanese Patent Application No. 2004-099184, filed March 30, 2004, Japanese Patent Application No. 2004-100698, filed March 30, 2004, Japanese Patent Application No. 2004-197730, filed July 5, 2004). Thus, the effective filing date of the instant application is March 15, 2005 which is earlier than the earliest publication date of Yoshimura.

In view of the above, Yoshimura does not serve as prior art under 35 U.S.C. § 102(a) nor under 35 U.S.C. § 102(b). Yoshimura also does not serve as prior art under 35 U.S.C. § 102(e) because WO 2006/035878 A1 of Yoshimura was not published in English (also the effective filing date of the instant application is earlier than the Internal Application Filing Date of WO 2006/035878 A1).

Applicants respectfully request withdrawal of this rejection.

CONCLUSION

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In light of the Applicant's amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. The grounds for rejection which are not discussed herein are moot and Applicants expressly do not acquiesce in the findings not separately addressed. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: June 10, 2009

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